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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,960	04/06/2001	Don J. Chandler	215063.02701.	6292

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EXAMINER	
LE, HOA T	
ART UNIT	PAPER NUMBER
1773	8

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/826,960	CHANDLER ET AL
	Examiner	Art Unit
	H. T. Le	1773

-- The MAILING DATE f this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 23, 24 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification only provides a description of the magnetic substance being chosen from magnetic **nano**spheres but does not describe magnetic substance chosen from **micro**spheres. There is no teaching or guidance as to how to select magnetic substance from microspheres.

2. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 26, lines 2 & 3, "microspheres" has no antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-19, 21, 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al (US 5,395,688).

Claims 1, 11, 12 and 16-18: Wang et al disclose coated particles comprising a core particle and a magnetically responsive material containing magnetic particles and polymeric material associated on the surface of said core. See col. 1, lines 36-51.

Claims 2 & 3: col. 3, lines 59-61.

Claims 4 & 5: col. 2, lines 56-59; col. 3, lines 3-28.

Claims 6-8 and 13: col. 3, lines 36-41.

Claims 9 and 10: col. 3, lines 5-8.

Claims 14: col. 5, lines 2-4.

Claim 15: col. 3, lines 10-12.

Claim 19: Col. 1, lines 36-51. The coated particles are fluorescent coated and thus comprise fluorescent tag as claimed.

Claims 21 and 25: See rejection to claims 1 and 6 above. See col. 1, lines 36-51 and examples.

Claim 22: Because the coating particles are bound to the core particle by a polymeric binder and thus they are covalently bonded to the core particle.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 20, 27 and 28 are rejected under 35 U.S.C. 103(a) as obvious over Wang et al (US 5,395,688) in view of Chandler et al (US 5,981,180).

As discussed above, Wang et al disclose magnetically responsive beads comprising particles and magnetic substance on the surface of the particles useful in various clinical fields comprising biological assays. However, Wang et al do not teach a method of pooling two subsets of such coated particles. Chandler et al teach a method of pooling of multiple subsets of beads for simultaneously detecting multiple analytes in a single assay step. See Chandler, col. 3, line 58 to col. 4, line 3. It would therefore have been obvious for one having ordinary skill in the art to apply the method taught by Chandler utilizing the coated particles of Wang in order to detect multiple analytes a one single assay step as suggested by Chandler.

7. Other references are cited as art of interest.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 703-308-2415. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Friday.

H. T. Le
Primary Examiner
Art Unit 1773

hl
March 9, 2003